

REMARKS/ARGUMENTS

In the Office Action claims 4 and 5 were rejected under 35 USC § 112, second paragraph, as being indefinite. In particular, claims 4 and 5 depend from a claim that has been cancelled. In this Amendment the dependency for claim four has been changed so that this claim now depends from claim 1. In addition, the limitations of claim 5 have been added to claim 1 and claim 5 has been cancelled. It is submitted that the amendment to claim four makes this claim definite and the Examiner is requested to withdraw the rejection under 35 USC § 112. As claim 5 has been incorporated into claim 1 there is no longer a dependency issue with regard to claim 5.

Claims 1-2, 6 and 8-13 were rejected under 35 USC § 102 (b) as being anticipated by the '307 Lam et al. patent.

Claim 1 has been amended to include the limitation of claim 5 wherein the secondary layer comprises about 20 to about 35%, by weight, of silica particles, and about 65% to about 80% carbon particles, based on the total weight of the friction modifying particles.

The Lam '307 reference is directed to a friction material having a fibrous base material formed of less fibrillated aramid fibers, synthetic graphite and at least one filler material. A secondary layer of carbon particles is positioned on at least one surface of the fibrous base material. However, the Lam '307 reference does not disclose or suggest a secondary layer comprising a mixture of carbon and silica friction modifying particles nor does this reference disclose the specific ranges for silica and carbon particles contained in the secondary layer as defined by applicants' amended claim 1. The applicants' do not agree with the Examiner's position that the '307 Lam et al. patent can be interpreted where silica particles that are a component of the primary layer now becomes a component of the secondary layer for this friction material. The '307 Lam et al. reference has separate primary and secondary layers and there is no disclosure or suggestion in this reference that

components of the primary layer becomes part of the secondary layer for the friction material. In addition, Applicants' claim 1 recites a base material and a separate secondary layer that is positioned on one surface of the base material. The secondary layer also has specific ranges for the materials that form the secondary layer. It is the Applicants' position that the '307 Lam et al. reference does not disclose or suggest the invention defined by amended claim 1 and that this reference does not form a proper basis for rejecting this claim under 35 USC § 102 (b). The other claims contained in this rejection all depend, either directly or indirectly, upon claim 1 and as claim 1 is patentably distinct over the '307 reference, these dependent claims are also patentably distinct over this reference. In view of the distinctions between the subject matter covered by amended claim 1 and the teaching of the '307 Lam et al. reference the Examiner is requested to withdraw the rejection under 35 USC § 102 (b) over the Lam et al. '307 reference.

Claims 1-4, 6-13 and 16-18 were rejected under 35 USC § 102 (f) on the basis that the Applicant did not invent the claimed subject matter.

As set forth above claim 1 has been amended to include the limitations previously found in dependent claim 5. This rejection under 35 USC § 102 (f) does not include claim 5 and it is submitted that amended claim 1 includes subject matter that is not taught or suggested in the '416 Lam et al. reference. As the limitations contained in amended claim 1 are not covered by the scope of this rejection it is Applicants' position that amended claim 1 and the claims that depend there from contain subject matter that is not taught by the '416 Lam et al. patent. Accordingly, it is submitted the rejection under 35 USC § 102 (f) is not appropriate as amended claim 1 and the claims that depend there from contain subject matter that is different then the teachings of the '416 Lam et al. reference. The amended claims for the instant invention define a very specific friction material that provides advantages over the friction materials disclosed in the references relied upon by the Examiner in this Office Action. The specific features of the friction material defined by the amended claims is not disclosed in the '416 Lam et al. reference and it is

Applicants' position that the different subject matter defined by the amended claims was invented by the Applicants' listed on this patent application. The subject matter contained in the '416 Lam et al. patent was invented by the inventors listed on that patent. However, as the amended claims contain subject matter not disclosed in the '416 reference it is submitted that the rejection under 35 USC § 102 (f) is not appropriate and the Examiner is requested to withdraw this basis of rejection for the claims.

Claims 5, 14, 15 and 19 were rejected under 35 USC § 103 (a) as being unpatentable over the '416 Lam et al. patent.

In this rejection the Examiner acknowledges that the features set forth in claims 5, 14, 15 and 19 are not taught by the '416 Lam et al. patent and that it would be necessary for one to determine the optimal amounts of the elements recited in the rejected claims. Applicants' agree with the Examiner that the friction material defined by the rejected claims is not disclosed in the '416 patent. It is further Applicants' position that the specific friction materials defined by the rejected claims is different than what is taught by the '416 patent and these claims are patentably distinct over the reference relied upon by the Examiner. The claims define a friction material that is different than what is taught by the reference there is no requirement that unexpected results be shown for the features contained in the rejected claims. However, the fact that these specific features are recited in the claims is clearly an indication that the inventors felt that these features provided a friction material with performance characteristics that are particularly advantageous. In view of the distinction set forth above it is Applicants' position that the '416 patent does not disclose or suggest the invention defined by the rejected claims and the Examiner is requested to withdraw this basis of rejection for the claims.

Claims 1-2 and 4-19 were rejected under double patenting over claim 5 of the '416 Lam et al. In addition, the Examiner indicated that the issue of priority under 35 USC § 102 (f) must be resolved.

Claim 1 has been amended to include the limitations previously found in claim 5 where specific ranges of friction modifying particles have been included in claim 1. The specific ranges of these friction modifying particles are not found in claim 5 of the '416 patent. Accordingly, it is the Applicants' position that amended claim 1 and the claims that depend there from define an invention that is different then what is covered by claim 5 of the '416 patent. This difference between the subject matter of amended claim 1 and claim 5 of the '416 reference is acknowledged in the rejection under § 103 (a), where the Examiner stated that the '416 reference was silent with respect to the amount of the silica and carbon particles contained in the secondary layer. The Examiner also indicated that limitations contained in claims 14, 15 and 19 were not taught by the '416 patent. In view of this acknowledged difference between the subject matter of amended claim 1 and the teachings of the '416 patent it is submitted that the double patenting rejection is not appropriate and the Examiner is requested to withdraw this basis of rejection for the claims.

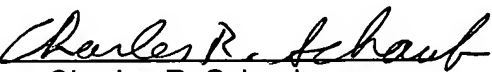
With regard to the priority issue under § 102 (f), it is the Applicants' position that the amended claims define an invention that is not disclosed or claimed in the '416 patent. In the Office Action the Examiner acknowledged that the '416 reference was silent with respect to the amount of silica and carbon particles recited in claim 5. As the limitations of claim 5 have been incorporated into amended claim 1, the claims of the present invention define an invention that is different then the invention covered by claim 5 of the '416 patent. This distinction between the subject matter covered by the amended claims defines an invention that is not disclosed nor claimed in the '416 patent. Accordingly, it is the Applicants' position that the subject matter contained in the amended claims is patentably distinct over the subject matter contained in the '416 patent and that the inventors listed on the current patent application are the inventors for the subject matter covered by the amended claims. In addition, the inventors listed on the '416 patent are the inventors for the subject matter contained in the claims of that patent. To the extent

that there is any overlap in the inventions covered by the current application and the '416 patent, the earlier filed '416 patent has priority with respect to §102 (f).

Applicants' are attempting to be as fully responsive as possible to the issue of priority of invention under 35 USC § 102 (f). Applicants' have amended claim 1 to include additional features that further differentiate the subject matter of the claims in the current application from the subject matter disclosed and claimed in the '416 patent. It is Applicants' position that the declaration previously filed in this patent application is consistent with the position we are taking that the invention in the present is different from what is disclosed and claimed in the '416 patent. If the Examiner has any questions concerning the sufficiency of the response to this rejection I would like to request that the Examiner call me so that we can discuss this issue in more detail. The Applicants' are attempting to respond to this basis of rejection as completely as possible to advance the prosecution of this application.

In view of the amendments to the claims and the arguments contained herein it is Applicants' position that the claims patentably distinguish over the prior art relied upon by the Examiner. Accordingly, a favorable action on the claims is respectfully requested.

Respectfully submitted,
EMCH, SCHAFFER, SCHAUB
& PORCELLO CO., L.P.A.

By: 
Charles R. Schaub
Reg. No. 27,518
Tel.: (419) 243-1294